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PATENT

TECH CENTER 1000/2900
Application No.: 09/820,856

#7
YC
11-0502

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL et al.

Application No.: 09/820,856

Filed: March 30, 2001

For: HEAT ACTIVATED DURABLE
STYLING COMPOSITIONS
COMPRISING C₁ TO C₂₂
SUBSTITUTED C₃-C₅
MONOSACCHARIDES AND
METHODS FOR SAME

Group Art Unit: 1615

Examiner: J. Venkat

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action mailed September 6, 2002, the Examiner has required
restriction between the following groups of claims:

- Group I** Claims 1-56, drawn to a composition comprising at least one film forming agent and at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain, classified in class 424, subclass 70.11 to 70.17;
- Group II** Claims 57-116, drawn to a method for durable non-permanent shaping or for durable retention of a non-permanent shape with a composition comprising at least one film forming agent and at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain, classified in class 424, subclass 70.11 to 70.17;
- Group III** Claims 117-166, drawn to a method for durable non-permanent shaping or for durable retention of a non-permanent shape with a composition comprising at least one film forming agent and at least

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one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain, classified in class 424, subclass 70.1;

Group IV Claims 167-212, drawn to a composition comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain, classified in class 424, subclass 70.1;

Group V Claims 213-216, drawn to a kit wherein at least one compartment comprises a composition comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain, classified in class 132, subclass 286+.

The restriction requirement, as set forth above and on pages 2-3 of the Office Action, is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group I, claims 1-56.

The Examiner states that the inventions are distinct because they are related as a "product and process of use" (Inventions I and II, Inventions III and IV), or as a "process and apparatus for its practice" (Inventions I or IV and V). See pages 3-4 of the present Office Action. Additionally, Inventions I and IV are unrelated because "Group I has two components and inventions IV has only one component." Page 3 of present Office Action. This rationale is also applied to show that Inventions II and III are unrelated.

Applicants refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

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M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden. According to the present Office Action, Inventions I - IV are all classified in the identical class 424. Moreover, Inventions I and II share the same subclass (70.11 to 70.17), as do Inventions III and IV (70.1). Finally, claim 1 of Invention I and claim 213 of Invention V require a composition comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁ to C₂₂ carbon chain where the at least one compound is present in an amount effective to impart a durable non-permanent shape to at least one keratinous fiber or to durably retain a non-permanent shape of the at least one keratinous fiber. Accordingly, a search for these groups of claims will substantially, if not completely, overlap. Thus, for at least this reason, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (202) 408-4173.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Chalvia V. Warrnemat, Reg No. 39,064
By: *for Anthony C. Tridico*
Anthony C. Tridico
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Date: November 5, 2002

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